



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

24

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/200,055	11/25/98	GARIBALDI	J 3176-7694

QM12/0124

BRYAN K WHEELLOCK  
HOWELL & HAERKAMP  
7733 FORSYTH BOULEVARD  
SUITE 1400  
ST LOUIS MO 63105

EXAMINER

SADULA, J

ART UNIT

PAPER NUMBER

3763

DATE MAILED:

01/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/200,055

Applicant(s)

GIRIBALDI et al.

Examiner  
Jennifer R. Sadula

Group Art Unit  
3763



☒ Responsive to communication(s) filed on Nov 25, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-40 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-40 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3763

## DETAILED ACTION

### *Information Disclosure Statement*

1. The Information Disclosure Statement as filed 8 March 1999 has been considered and is submitted herewith as paper number 4.

### *Specification*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Objections*

3. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

4. Applicant is advised that should claim 2 be found allowable, claim 8 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Art Unit: 3763

5. Other pairs of claims fitting this criteria are: claims 3 and 9, 4 and 10, 5 and 11, 6 and 12.

Appropriate correction on all counts is required.

***Claim Rejections - 35 U.S.C. § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 3-5, 9-11, 15-17, 26-28, 30 and 33-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 3, 9, 15, 26 and 33 are pointed out to the applicant for having “flexible magnetic material”. Although no correction is required, it is necessary to point out the relative nature of the term “flexible”. The term is defined with regard to other objects. The examiner notes her

---

desk to be more “flexible” than the stone in her ring. Almost any material is noted to have a certain flexibility in the art and therefore is dependent upon the perspective of one interpreting the claim language.

9. Claim 30 is rejected for claiming a “stricture”. Examiner is unaware if this is a typographical error (such as a “structure”) or if this is a term for part of the device (applicant can be one’s own lexicographer). Appropriate correction is therefore required.

Art Unit: 3763

10. Claims 4, 10, 16, 27 and 34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not shown why the device is improved by a plurality of magnets. The specification clearly lacks criticality for such a modification.

11. Claims 5, 11, 17, 28 and 35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not shown why the device is improved by a permeable magnet. The specification clearly lacks criticality for such a modification.

***Claim Rejections - 35 U.S.C. § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-3, 6-9, 12-15, 18-26, 29-33 and 36-40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Anderson ('362). Anderson teaches an endotracheal tube control device including a stylet or guide device maintaining a greater length than the tubular member and a magnetic means attached to the distal end of the stylet. The method is taught to utilize a second

Art Unit: 3763

magnetic means for external placement over the orifice of the patient. The device is inherently pushed at the proximate end and pulled via magnetic force at the distal end. The magnetic material is inherently flexible with regard to other materials.

***Claim Rejections - 35 U.S.C. § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 4-5, 10-11, 16-17, 27-28 and 34-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Anderson. Anderson teaches the device as disclosed but does not get specific as to the "magnetic means" or the materials utilized. It is well settled in the art that one magnet may replace many magnets, or vice versa. It is also well settled in the art that "magnetic means" is interpreted as inherently disclosing

Art Unit: 3763

both permeable or non-permeable substances so long as the material utilized displays magnetic properties. It is further well understood that metals are merely a sea of electrons and are known to be on some level porous- as far fetched as that may seem. Yet it is understood by the examiner that such might not be in agreement with that the applicant has in his mind as the invention.

Therefore it is further obvious to one of ordinary skill in the art at the time of invention to make such a design modification at the device level as the applicant has taught (via a lack of criticality within the specification) that such merely a design modification. It is this examiners assertion that it is further obvious for the purposes as detailed above in support of inherency.

17. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Viera ('023). Anderson teaches the device substantially as claimed however fails to point out the "magnetic means" as more than one magnet, or multiple annular magnets radially spaced apart as specified. Viera teaches such a magnet utilized in the same art. It is well settled that "magnetic means" incorporates any structure displaying magnetic field and forces. Clearly it would have been obvious to one of ordinary skill in the art at the time of invention to make or use the device of Anderson with the magnetic means of Viera for the purposes of creating a region of increased angularity.

### ***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer R. Sadula whose telephone number is (703) 308-2977. The


Art Unit: 3763

examiner can normally be reached on Monday- Thursday from 9am to 6pm. The examiner can also be reached on alternate Fridays.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Wood Coggins, can be reached on (703)308-1344. The fax phone number for this art unit is (703) 308-0758.

20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

  
WYNN WOOD COGGINS  
SUPERVISORY PATENT EXAMINER

  
Jennifer R. Sadula  
12 January 2000